

Claim 11 has been amended to correct the characterization of polyquaternium-10 (see definition from the *International Cosmetic Ingredient Dictionary and Handbook* attached to this communication)

35 U.S.C. 112, second paragraph rejections

Claims 1, 4 and 5 were rejected by the examiner as being vague and indefinite for the following reasons (applicant's response follows thereafter):

(1) It is noted that the term "Cellulose derivative" has been used in 309 issued U.S. Patents from 1/1/1996 through 6/18/2002, including U.S. Patent 6,207,653 (Primary Examiner was Russell Travers). 35 U.S.C. 282 states that every patent is presumed to be valid. It is unclear how the term could be presumed to be valid in these other patents and not be considered to be in the present application especially when the applicant's use of the term is narrower than that of the patents cited (i.e. applicants' refer to "cationic" cellulose derivatives).

(2) The phrase "condensation products of polyglycols and amines" was stated as being vague and indefinite because the "metes and bounds of the claim are not clear (sic) defined".

The examiner is reminded that MPEP 2111.01 states that the words of a claim must be given their "plain meaning" unless they are defined in the specification (see also *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Each of the terms in the phrase have a definitive meaning within the art and as such one of ordinary skill in the art would be able to contemplate the scope of compounds defined by the term. By way of example, the following definitions are from the McGraw-Hill Dictionary of Chemical Terms:

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|-----|------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| (a) | condensation reaction: | One of a class of chemical reactions involving a combination between molecules or between parts of the same molecule. |
| (b) | polyglycols: | A dihydroxy ether derived from the dehydration (removal of a water molecule) of two or more glycol molecules; an example is diethylene glycol, $\text{CH}_2\text{OHCH}_2\text{OCH}_2\text{CH}_2\text{OH}$. |
| (c) | amines: | One of a class of organic compounds which can be considered to be derived from ammonia by replacement of one or more hydrogens by organic radicals. |

(3) Claim 5 (and claim 9) has been amended to include the unit "by weight". Claim 4 already had this unit of measurement in the claim.

35 U.S.C. 103(a) rejection

Claims 1-5, 7-9 and 11 were rejected by the examiner as being obvious over Schreiber et al. (WO 98/17232) in view of Dupuis et al. (U.S. Patent 6,338,858) and Yoneyama et al. (U.S. Patent 5,015,469).

Schreiber et al. reference

The examiner acknowledges that the Schreiber et al. reference does not teach cationic polymers. It is also noted that Schreiber et al., when considering the reference as a whole, does not teach or suggest emulsions wherein the water content is at least 80% by weight or a oil phase (lipids, emulsifiers and lipophilic constituents) of less than 20% by weight.

It has previously been held that a claim interpretation that excludes the preferred embodiment "is rarely if ever correct". (see *Vitrionics Corporation v. Conceptronic, Inc.*, 90 F.3d 1583, 39 USPQ2d 1578 (Fed. Cir. 1996)). Schreiber et al. discloses 27 examples, none of which have the claimed water phase or oil phase ranges claimed by the applicants (Examples 1-17 all have in common caprylic/capric triglyceride; octyldodecanol; dicaprylylether and C₂₀-C₄₀-alkylstearate which total 30% by weight; Examples 18-27 all have in common caprylic/capric triglyceride; octyldodecanol; dicaprylylether; cetearylbehenate and octacosanylstearate which total 24% by weight).

Moreover, if the examiner is relying upon the preferred teachings to support her position with respect to oil phase content (i.e. 1-20% by weight); the examiner cannot selectively discount Schreiber et al.'s preferred range of water content (i.e. between 50-75% by weight, see e.g. page 15, lines 18-20 of Schreiber et al.). It is also noted that Schreiber et al.'s lipid phase also comprises of wax components (which also has a preferred range of 1-20% by weight; see page 15, lines 13-14). As such, the preferred weight range of Schreiber et al.'s lipid phase is at least 2-40% by weight (this is consistent with the oil content within each of their examples).

Combining Dupuis et al. and Yoneyama et al. with Schreiber et al.

Dupuis et al. and Yoneyama et al. are relied upon by the examiner for their teachings of cationic polymers and liquid paraffin respectively. However, the inventions of Dupuis et al. and Yoneyama et al. are not isolated to the use of cationic polymers, i.e. the cationic polymers disclosed are part of a multicomponent composition which is the inventive concept of their respective inventions.

When considering each of these references as a whole, it is clear that they are different inventions from that of Schreiber et al. or the applicants' invention and as such do not lend themselves to be combined with the Schreiber et al. reference nor is there is a suggested motivation for making the appropriate substitution.

Dupuis et al. is directed toward **solid** topical compositions. The only mention of a water-in-oil emulsion comes from the description of an optional ingredient as part of their solid topical composition (see col. 5, lines 51-57 - "The composition according to the invention **can** also comprise a fatty phase...In this case, the fatty phase can be dispersed in the gel,

in particular in the form of an emulsion of oil-in-water or water-in-oil type."). Even if Dupuis et al. were directed to a water-in-oil emulsion, the solid state requirement as well as the viscosity requirements disclosed by Dupuis et al. teach away from an emulsion like that of the applicants invention which requires at least 80%.

Yoneyama et al. disclose a water-in-oil type composition which contains an ammonium salt-type cationic surfactant (not a cationic polymer) and liquid paraffin. However, the broadest disclosure of Yoneyama et al.'s invention also requires the presence of a water-swellaable clay material, one or two more kinds of polyoxyalkylene modified organopolysiloxane and an oil phase which contains an organic silicone resin. When viewing various embodiments of Yoneyama et al.'s invention, it is clear that they do not disclose or intend to disclose water-in-oil compositions which require at least 80% by weight water phase (the highest figure disclosed is 56.5%).

not accurate
The suggestion to add a cationic polymer from the Dupuis et al. teaching only comes from a generic reference to other optional ingredients (no mention in any of the examples or in the claims) and then only for the types of compositions taught by Dupuis et al. not those of Schreiber et al. The examiner concludes that "the addition of cationic polymers for cosmetic purposes in the compositions of Schreiber et al. would be within the skill of one in the art."

The suggestion to add a liquid paraffin from the Yoneyama et al. teaching is only appropriate for the emulsion types of Yoneyama et al. and not for those taught by Schreiber et al. The examiner concludes that "the replacement of one [liquid paraffin] for the other [isopropyl myristate and silicone oils] for cosmetic purposes would be within the skill of one in the art."

It is noted that "within the skill of one in the art" has previously been held to be insufficient to establish a holding of obviousness without some **objective reason to combine the teachings of the references** (see MPEP 2143.01, page 2100-124 and *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993)).

The examiner appears to rely on similarity of composition form as the "objective reason" to combine the references, i.e. since the compositions are similar, one could add a particular component from one composition to another composition. However, as commented above, the composition are not similar; even if *in arguendo* the compositions were analogous, none of the references provides an objective reason as to why one of ordinary skill in the art would be motivated to select a particular ingredient from a multicomponent composition and adding it to another composition (i.e. would not be considered to be improper "picking and choosing").

While it is well known that a prior art reference can be used for what it teaches and not just the claimed invention, MPEP 2141.02 makes the contingency that "A prior art reference must be considered in its entirety, i.e. as a **whole, including portions that would lead away from the claimed invention.**" (see MPEP 2141.02 and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). It has also been held that **"[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion**

of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))

More recently, it has been held that "...***Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.***" see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, ***the prior art must provide a suggestion or motivation*** to make such a combination.")" see *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

Closing

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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Attachment: - Definition of polyquaternium-10 from International Cosmetic
Ingredient Dictionary and Handbook
- Definition of terms from Hawley's Condensed Chemical Dictionary
- Copy of Claims Showing Amendments Made

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (9 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 6 December 2002

By: _____
Vilma I. Fernandez